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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,205	10/28/2003	Bennett M. Richard	D5407-216	4513
25397	7590	09/14/2006	EXAMINER	
DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY SUITE 3150 HOUSTON, TX 77027			COZART, JERMIE E	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/695,205

**Applicant(s)**

RICHARD ET AL.

**Examiner**

Jermie Cozart

**Art Unit**

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10,11 and 15-17 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: securing said filter layer to said base pipe without adhesives or mechanical fasteners.

### ***Claim Objections***

2. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 does not further limit claim 2 or independent claim 1 because the base pipe has already been expanded in claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2, 4-9, and 12-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for securing said filter layer to said base pipe by expanding said base pipe, does not reasonably provide enablement for additionally securing said filter layer to said base pipe without welding, adhesives, or mechanical fasteners. The specification does not enable any person skilled in the art to

Art Unit: 3726

which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Claim 1 as now amended requires securing said filter layer to said base pipe by expanding said base pipe. Claim 5 which depends from claim 1 and claim 9 which depends from claim 8 which depends from claim 2 which depends from claim 1, both require securing said filter layer to said base pipe without welding, adhesives, or mechanical connectors. The specification discloses expanding said base pipe as one example of securing said filter layer to said base pipe without welding, adhesives, or mechanical fasteners, and does not disclose the securing the filter layer to base pipe without welding, adhesives, or mechanical in addition to previously securing the filter layer to the base pipe by expanding said base pipe. Appropriate correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 5 and 9, it is unclear as to whether the step of securing is an additional step of securing, an attempt to broaden to broaden the scope of the securing step of claim 1, or an attempt to further limit the scope of the securing step of claim 1. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3726

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 4, 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Echols et al. (US 6,941,652 B2).

Echols discloses manufacturing a screen (40) for downhole use by inserting a base pipe (38) into a cylindrically shaped filter layer (40), securing the filter layer (40) to the base pipe (38) by expanding (col. 5, lines 1-4) the base pipe (38). An interference fit is created between the base pipe and filter layer by expansion (col. 5, lines 1-4) of the base pipe. The size of the filter layer (40) is reduced (i.e. compressed). The base pipe (38) and filter layer (40) are inserted downhole, and the base pipe (38) is expanded downhole. A projective jacket (42) is mounted over the filter layer (40) before inserting the base pipe (38). *See column 3, line 27 – column 6, line 56, and figures 1A-7 for further clarification.*

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echols et al. (US 6,941,652 B2).

Echols discloses expanding the base pipe, however, Echols does not expressly disclose expanding the base pipe for at least a portion of the length of the filter layer, expanding the base pipe near the ends of the filter layer, or expanding the base pipe for the entire length of the filter layer and beyond.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to expand the base pipe for at least a portion of the length of the filter layer, to expand the base pipe near the ends of the filter layer, and to expand the base pipe for the entire length of the filter layer and beyond because Applicant has not disclosed that expanding the base pipe for at least a portion of the length of the filter layer, expanding the base pipe near the ends of the filter layer, or expanding the base pipe for the entire length of the filter layer and beyond provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the expanding of the base pipe as taught by Echols because the screen is secured to the base pipe by expansion.

Therefore, it would have been an obvious matter of design choice to modify Echols to obtain the invention as specified in claims 12-14.

***Allowable Subject Matter***

11. Claims 10, 11, and 15-17 are allowed.

***Response to Arguments***

12. Applicant's arguments with respect to claims 1, 2, 4-9, and 12-14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

Art Unit: 3726

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**JERMIE E. COZART**  
**PRIMARY EXAMINER**

September 8, 2006